



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/760,426	01/12/2001	David J. Legare	102P013	2329

28264 7590 04/19/2004

MICHAEL P. WILLIAMS
BOND, SCHOENECK & KING, PLLC
ONE LINCOLN CENTER
SYRACUSE, NY 13202

EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT	PAPER NUMBER
----------	--------------

1772

DATE MAILED: 04/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/760,426

Applicant(s)

LEGARE, DAVID J.

Examiner

Alicia Chevalier

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 5, 13 and 15-23 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6, 8, 9, and 14 is/are allowed.
- 6) ☒ Claim(s) 1-4, 7 and 10-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

RESPONSE TO AMENDMENT

1. Claims 1-23 are pending in the application, claims 5, 13 and 15-23 are withdrawn from consideration.
2. Amendments to claims, filed on January 26, 2004, have been entered in the above-identified application.

REJECTIONS REPEATED

3. The 35 U.S.C. §103 rejection of claim 1 as over Sugahara et al. (US Patent No. 4,018,616) in view of Shodai et al. (US Patent No. 3,793,055) or Ishida et al. (US Patent No. 3,622,732) is repeated for reasons previously made of record in paper #13, mailed November 7, 2003, pages 2-3, paragraph #3.
4. The 35 U.S.C. §103 rejection of claim 7 as over Sugahara in view of Shodai or Ishida and further in view of Blount (US Patent No. 4,291,154) is repeated for reasons previously made of record in paper #13, page 3, paragraph #4.
5. The 35 U.S.C. §103 rejection of claims 1-4 as over Kallstrom (EP0222720A2) in view of Sugahara and Shodai or Ishida is repeated for reasons previously made of record in paper #13, page 4-5, paragraph #5.
6. The 35 U.S.C. §103 rejection of claims 7 and 10-12 as over Kallstrom in view of Sugahara and Shodai or Ishida and further in view of Blount is repeated for reasons previously made of record in paper #13, pages 5-6, paragraph #6.

Allowable Subject Matter

7. Claims 6, 8, 9 and 14 are allowed.

ANSWERS TO APPLICANT'S ARGUMENTS

8. Applicant's arguments in response filed on January 26, 2004 regarding the claim 1 of record have been carefully considered but are deemed unpersuasive.

Applicant argues that Sugahara discloses the addition of the magnesium chloride only for the preparation of the coating composition and that it is irrelevant whether Shodai or Ishida teach interchangeability of calcium chloride with magnesium chloride as the composition disclosed in Sugahara.

First, Sugahara discloses that the fire protective composition can comprise either calcium carbonate or magnesium chloride (*col. 33, lines 63-64*). So, Sugahara does disclose that other polyvalent metals can be used in the preparation of the composition. Therefore, the fact that Shodai or Ishida disclose that calcium chloride is interchangeable with magnesium chloride is relevant. Second, the fact that the magnesium chloride is an intermediate in the composition is irrelevant since the wall composition did comprise it and was made from it.

9. Applicant's arguments in response filed on January 26, 2004 regarding the claim 7 of record have been carefully considered but are deemed unpersuasive.

Applicant argues that motivation to use Blount is deficient in two regards.

First Applicant argues that the motivation is only applicable to instances where lowering the pH would be advantageous. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for

Art Unit: 1772

patentability when the differences would otherwise be obvious. Therefore, it is irrelevant that Applicant's invention does not need the benefits from the buffering of the pH.

Second Applicant argues Blount does not expressly teach lowering the pH affects the flammability of the composition. Blount discloses fireproof composition comprising water glass cured with disodium phosphate (*dibasic sodium phosphate*) to help lower and neutralize the pH level (*col. 13, lines 23-45*). Since the composition is fireproof it is less flammable than a non-fireproof composition and the pH level is part of the reason the composition is fireproof.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.


Art Unit: 1772

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ac

4/16/04


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

4/16/04